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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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John Carnahan

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HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON, DC 20006-1109

EXAMINER

CHENCINSKI, SIEGFRIED E

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 02/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/552,879	Applicant(s) CARNAHAN ET AL.	
	Examiner Siegfried E. Chencinski	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/1/01 & 8/30/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. (a) Applicant indicates that he has not received a signed copy of PTO Form 1449 which had been submitted by applicant with one newspaper article on January 22, 2004. The examiner is unable to determine why this IDS submission was not returned signed with another signed 1449 attached to the Office action dated March 9, 2004. The Office regrets any inconvenience to Applicant for this omission.
- (b) A signed copy of said 1449 is enclosed, along with a signed copy of Applicant's 70 IDS submissions received on August 30, 2005.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 21-23, 27-30 and 34 are rejected** under 35 U.S.C. 102(e) as being anticipated by Wallman (US Patent 6,601, discloses anticipates a system and method for multivariable comparison of financial information, comprising:

Re. Claims 21 & 28, Wallman discloses a system and method for multivariable comparison of financial information, comprising:

- a) receiving weightable search information from a client interface, the weightable search information comprising user-selected quantitative search criteria and user-selected weighting criteria, the weighting criteria reflecting user-defined levels of importance for one or more of the quantitative search criteria (1. Interface - Abstract, II. 3-6, 10-015, Col. 13, II. 33-34, 41-43; Col. 23, II. 18-19. 2. weightable search information – (preferences – Col. 25, II. 22-25), Abstract, II. 6-8; weightable – Col. 20, I.

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42; Col. 25, I. 56; Col. 26, I. 22; adjustable weighting - Col. 31, I. 23. 3. Quantitative criteria – Col. 23, II. 4-5; Col. 25, II. 52-54; Col. 26, II. 5-9); and

b) accessing at least one network-enabled information source comprising financial information regarding a plurality of investment funds, each investment fund having multiple quantitative investment fund variables associated therewith (network-enabled information - Fig. 1-6; Col. 23, II. 36-43; funds – Col. 17, I. 51);

c) comparing the quantitative investment fund variables with the user-selected quantitative search criteria and the user-selected weighting criteria (Funds - Col. 17, II. 18-27; weightable – Col. 20, I. 42; comparing to the criteria – Col. 24, II. 10-12; Col. 26, II. 5-9);

d) generating search results comprising.- investment funds that do not satisfy all of the user-selected quantitative search criteria, but which satisfy the overall user-defined criteria based on the combination of the user-selected weighting criteria and the user-selected quantitative criteria (Col. 17, I. 51; Col. 31, II. 30-43.).

Wallman does not explicitly disclose a first set of investment funds that do not satisfy all of the user-selected quantitative search criteria, but which satisfy the overall user-defined criteria based on the combination of the user-selected weighting criteria and the user-selected quantitative criteria. However, the ordinary practitioner would have found it obvious that a first set of investment funds etc. is taught to be presented to the investor by Wallman. This is suggested by Col. 13, II. 30-33 (suggesting modifications, etc.), and by Col. 14, II. 29-44. Further, this latter teaching offers the investor scalable criteria to choose from, such as a range of values, and to adjust weightings of the portfolio characteristics. As a result, the ordinary practitioner of the art at the time of Applicant's invention would have found it obvious to adapt the teachings of Wallman to present a system and method for multivariable comparison of financial information, motivated by a desire to enable a user, at a reasonable cost, to create and manage a complex and diversified portfolio of such securities or other assets (Col. 1, II. 27-29).

Re. Claims 22 & 29, Wallman discloses system and method wherein the one or more investment funds comprise one or more mutual funds (Col. 17, II. 18-54). Wallman teaches that mutual funds are included in his broad definition of investment funds (Col.

17, ll. 21-24). Further, even though Wallman points out certain advantages to an investor's personal selection and maintenance of individual investments in a portfolio, he nevertheless states the ability of his system and method to include any kinds of investment funds in his system and method, such as those typically contained in an IRA or 401(k) account, as part of a comprehensive approach if an investor prefers to manage all of his investment holdings through Wallman's system (Col. 17, ll. 34-54).

Re. Claims 23 & 30 Wallman discloses a system and method further comprising a results interface operative to display the search results to the user (Fig's 5, 7, 8, 13, 15; Col. 32, ll. 29-40).

Re. Claims 27 & 34, Wallman discloses a system and method wherein the search results further comprise a second_set of search results comprising investment funds that satisfy all of the user-selected quantitative search criteria (Col. 33, ll. 33-36. It is inherent that the search results accepted by the investor meet all of his quantitative search criteria., and that this set of search results can reasonably be classified as a "second" set of search results.).

3. Claims 24 & 31 are rejected under 35 U.S.C. 103(a) as being disclosed by Wallman in view of O'Shaughnessy (US Patent 6,317,726 B1).

Re. Claims 24 & 31, Wallman discloses a system and method wherein the results interface comprises a graphical user interface operative to display the one or more investment (Col. 13, 32-34; Col. 17, l. 51). Wallman does not explicitly disclose the display of the one or more investment funds in a sortable list. However, O'Shaughnessy discloses the display the one or more investment funds in a sortable list (Col. 18, ll. 42-46, 50-62). Therefor, it would have been obvious to an ordinary practitioner of the art at the time of the invention to have combined the art of Wallman with the art of O'Shaughnessy for the purpose of permitting the evaluation of search results in various sortable sequences in order to help reduce the complexity of the evaluation of investment information through a rule-based presentation available through automated sorting schemes to aid in investment decision making (O'Shaughnessy, Col. 1, ll. 45-51).

4. Claims 25, 26, 32 & 33 are rejected under 35 U.S.C. 103(a) as being disclosed by Wallman in view of Hambrecht et al. (US Patent 6,629,082 B1, hereafter Hambrecht).

Re. Claims 25, 26, 32 & 33, as shown in the rejection of claims 22 and 29 above, it would have been obvious to an ordinary practitioner at the time of Applicant's invention to have seen Wallman's teaching as disclosing a system and method wherein the one or more investment funds comprise one or more mutual funds. Wallman explicitly discloses a results interface operative to receive requests for a prospectus or for an application for one or more of the one or more mutual funds. However, Hambrecht disclose a hot link to an investment prospectus and to an investment application for a new issue of a financial security (Col. 9, ll. 7-17; Col. 10, l. 31 – Col. 11, l. 10). It would have been obvious to an ordinary practitioner of the art at the time of the invention to have adapted the hot links tool for ordering information to a web site offering information on financial investments, including for a prospectus or for an application for one or more of the one or more mutual funds. It would therefor have been obvious to the ordinary practitioner to combine the art of Wallman with the art of Hambrecht for the purpose of offering a hot link attached to a financial information search web site's results interface for receiving requests for investment information such as a prospectus of a financial investment, including a mutual fund, and for ordering an application to invest in one or more financial securities, including mutual funds. The motivation would have been to enhancing the ability of an investor to bid for securities on a more equal footing by being better informed (Hambrecht, Col. 1, ll. 48-51).

Response to Arguments

5. Applicant's arguments filed September 8, 2005 regarding claims 21 and 28 have been fully considered but they are moot in view of the new ground(s) of rejection which were required by applicant's amendments to independent claims 21 and 28.

Applicant's arguments filed September 8, 2005 regarding prior limitations of claims 21 and 28 and claims 24, 31, 25, 26, 32 and 33 have been fully considered but they are not persuasive.

ARGUMENT A: ... 'the Wallman patent fails to expressly or inherently disclose the claimed features of "weighting criteria reflecting user-defined levels of importance for one or more of the quantitative search criteria" and generating search results comprising "a first set of investment funds that do not satisfy all of the user-selected quantitative search criteria, but which satisfy the overall user-defined criteria based on the combination of the user-selected weighting criteria and the user-selected quantitative criteria," as recited in independent claims 21 and 28' (p. 2, l. 22 – p. 3, l. 2).

RESPONSE A:

(1) USER DEFINED LEVEL OF "IMPORTANCE"

Note on interpretation of claim terms Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...".

The instant application contains no such clear definition for the phrase "user defined level of importance" The phrase is broadly supported in the specification, first in the background section by stating that the prior art does "not afford "the opportunity to create a sliding scale of importance to be applied to the various quantitative factors supported by the search engine, or to sort out results once hits are found based on the weights" (p. 2, ll. 12-15). by some general commentary about weighting of user preferences and some examples thereto, and references to the drawings, which show screen shots of a limited selection of buttons a user can click and in the drawing by a reference to maintaining "the user's purchase history" in a user

profiles database.¹ But that is an example usage, and does not meet the requirements for a “clear definition.” In the instant case, the examiner is required to give the term “item selection histories” its broadest reasonable interpretation, which the examiner judges to be any collection comprising item selection histories. Those skilled in the art would recognize that maintaining a processed reduction of “item selection histories”, as *links table 301* does, reads on maintaining item selection histories, in much the same fashion that a Boeing 747 airliner is an airliner, and in turn an aircraft or an airplane.

(2) Re. "weighting criteria reflecting user-defined levels of importance for one or more of the quantitative search criteria": As stated above and in the last Office action, Wallman anticipates this limitation in the following places in combination with his overall teaching. One key claim criterion to keep in mind is the phrase “one or more”, which makes this a low hurdle to read on. Wallman reads on weighting criteria in numerous places, including: ((a) weightable search information – (preferences – Col. 25, ll. 22-25), Abstract, ll. 6-8; (b) weightable – Col. 14, l. 40; Col. 20, l. 42; Col. 25, l. 56; Col. 26, l. 22-capitalization-weighted; (b) adjustable weighting - Col. 31, l. 23. (c) Quantitative criteria – Col. 23, ll. 4-5; Col. 25, ll. 52-54; Col. 26, ll. 5-9);

ARGUMENT B: Re. Claims 24, 31, 25, 26, 32 and 33, and their rejections under 35 U.S.C. 103(a), no *prima facie* case of obviousness exists because O'Shaughnessy and Hambrecht do not cure the deficiency of Wallman of Argument A (p. 10, l. 8 – p. 11, l. 16).

Re. Claims 24 & 31: “O'Shaughnessy fails to cure the deficiency of the rejection of independent claims 21 and 28, from which claims 25, 26, 32 and 33 depend, and thus no *prima facie* case of obviousness exists because the combined references fail to teach or suggest all the claims limitations” (p. 10, l. 26 – p. 11, l. 2).

Re. Claims 25, 26, 32 and 33: “Hambrecht *et al.* fails to cure the deficiency of the rejection of independent claims 21 and 28, from which claims 25, 26, 32 and 33 depend, and thus no *prima facie* case of obviousness exists because the combined references fail to teach or suggest all the claims limitations.

¹ Col. 7 lines 45-53 of the parent patent, US006317722B1.

RESPONSE B:

Re. Claims 24 & 31: O'Shaughnessy has not been used in the rejections of claims 21, 24, 28 and 31 as a prior art reference to cure Argument A. Applicant's argument is thus moot.

Re. Claims 25, 26, 32 and 33: Hambrecht has not been used in the rejections of claims 21, 24, 28 and 31 as a prior art reference to cure Argument A. Applicant's argument is thus moot.

Conclusion

6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is (571)272-6792. The Examiner can normally be reached Monday through Friday, 9am to 6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Hyung S. Sough, can be reached on (571) 272-6799.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks, Washington D.C. 20231

or faxed to:

(571) 273-8300 [Official communications; including After Final communications labeled "Box AF"]

(571) 273-6792 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the address found on the above USPTO web site in Alexandria, VA.

SEC

January 17, 2006



ALEXANDER KALINOWSKI
SUPERVISORY PATENT EXAMINER